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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,441	10/16/2000	Bayard S. Webb	0112300/141	1896

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BELL, BOYD & LLOYD LLP  
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EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/688,441

Applicant(s)

WEBB ET AL.

Examiner

William H. McCulloch Jr.

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-38 is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. An appeal brief was filed 10/16/2006. A notice of non-compliant appeal brief was mailed to applicant on 12/1/2006, and withdrawn in a communication mailed 12/26/2006. This action is made in response to a newly cited reference to Bennett as detailed below. As such, prosecution on the merits is hereby reopened.

#### ***Allowable Subject Matter***

2. Claims 29-38 were previously indicated allowable. Such position is maintained herein.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19 and 20-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,572,471 to Bennett (hereinafter Bennett).

Regarding claims 1, 13, and 24, Bennett teaches a game device comprising: a plurality of symbols (prize value symbols, see at least figs. 2-5 and descriptions thereof); a plurality of independent rounds (see at least 1:56-67); means for enabling a player to select one of said symbols in each of the independent rounds (player selection means, see at least 3:29-43); a display device operable for displaying said plurality of symbols

Art Unit: 3714

(game display means 11, see *Id.*); and a controller operable with the selection means and the display device to randomly determine for each of a plurality of said independent rounds whether to assign an item to at least one, a plurality of or all of the plurality of symbols, wherein said determination for each round is independent of said other rounds (control program implemented on game control processor circuits, see at least 3:24-28 and 4:33-53), and upon said determination being made, to assign the item to one of said symbols, to a plurality of said symbols or to all of said symbols (see *Id.*), to enable the player to select one of the symbols in each of the rounds, and to provide an award to the player for each of said rounds if said player selects one of the symbols having said assigned item in said round (see at least 4:15-29). Claims 13 and 24 are directed toward methods that are substantially encompassed by the teachings of Bennett as applied to the limitations of the device embodiment of claim 1.

Regarding claim 2, Bennett teaches that an item may be assigned to a plurality of symbols in each round. Figure 9, for example, shows that a \$1 item may be assigned to multiple symbols.

Regarding claim 3, the examiner interprets recitation of "table" as a data structure implemented by the gaming device that contains the possible items that may be assigned to the symbols. Bennett teaches such in at least 4:33-53.

Regarding claim 4, the examiner reiterates the above interpretation of "table". Furthermore, figure 9 of Bennett shows that at least one item (e.g. \$1 item) is adapted to be randomly selected more often than at least one other item (e.g. \$1000 item).

Regarding claims 5-6, the examiner interprets the recitation of "a table of numbers" as a data structure implemented by the gaming device to dictate the number of rounds that a player may play the game. Bennett teaches such in at least a predetermined number of free games in 2:39-41.

Regarding claim 7-8, the examiner interprets the recitation of "a plurality of tables of numbers" as a collection of numbers, substantially similar to the interpretation applied in claims 3-6.

Regarding claims 9-10, Bennett teaches a quantity of tables of numbers (using the interpretation of claims 7-8) that equal the quantity of symbols in a round for a given choice of the number of symbols provided to the player (see at least 1:56-67).

Regarding claim 11, the examiner reiterates the interpretation of "table" described above in regard to claim 3. Bennett teaches such in relation to figure 9, wherein the randomly selectable prizes correspond to the randomly selectable items. Regarding claim 12, the randomly selectable prizes correspond to the randomly selectable items and at least one of the prizes (e.g. \$1 prize) is adapted to be randomly selected more often than at least one other prize (e.g. \$1000 prize).

Regarding claims 14 and 17, Bennett teaches such in at least a predetermined number of free games in 2:39-41.

Regarding claim 15, 16, and 18, Bennett teaches different percentage of symbols is associated with different probabilities determining the assignment of the item to the symbols in the plurality of rounds to be played (see at least figs. 6 and 10 and 2:1-31).

Regarding claims 20-21, the claims are directed toward repeating the steps of claim 13 until the player selects a number of times equal to (1) a selected number of rounds, said selected number being associated with a percentage of symbols that have an assigned item, or (2) a sum of a plurality of selected numbers, said selected numbers of rounds each being associated with a different percentage of symbols that have an assigned item. Bennett teaches such in at least abstract, 2:39-41, and 4:15-29.

Regarding claim 22, Bennett teaches revealing that a symbol has been assigned an item when a player selects said symbol having said assigned item (see at least 3:29-43).

Regarding claim 23, Bennett teaches the step of revealing all of the symbols that were assigned an item when a player selects one of the symbols that was not assigned said item (see at least 3:63-4:11).

Regarding claims 25-27, Bennett teaches a step of selecting a prize, a step of providing the prize to the player if the player chooses a symbol having said assigned item, and a step of revealing that a symbol has an assigned item when said player selects a symbol having said assigned item (see explanation of claims 1, 11-13, 22, and 24 above).

Regarding claim 28, Bennett teaches the step of revealing that all symbols having an assigned item indeed have said assigned item when said player selects a symbol not having an assigned item (see at least 3:63-4:11).

***Response to Arguments***

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.  
Examiner  
Art Unit 3714

wm



**CORBETT B. COBURN**  
PRIMARY EXAMINER



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